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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/211,755	12/15/98	JONES	K 54002-D/JFW/

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HM22/0710

EXAMINER  
BRANNOCK, M

ART UNIT	PAPER NUMBER
1646	22

DATE MAILED: 07/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/211,755

Applicant(s)  
Jones, KA

Examiner  
Michael Brannock, Ph.D.

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1646



-- Th MAILING DATE of this communication appears on th cover sheet with the correspondenc address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 25, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 190-249 is/are pending in the applica
- 4a) Of the above, claim(s) 190-207, 209, 211, 212, 215-220, 226, 227, 232, and is/are withdrawn from considera
- 5) ☒ Claim(s) 213, 214, 221-223, 231, and 233-240 is/are allowed.
- 6) ☒ Claim(s) 208, 210, 224, 225, and 228-230 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirem

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 21
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 4/25/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09211755 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Status of Application: Claims and Amendments***

2. Claims 190-249 are pending. Claims 208, 210, 213, 214, 221-225, 228-231, and 233-240, as the claims relate to methods of screening for an agonist of a GABA<sub>B</sub>R1/R2 receptor, are currently under examination.

Applicant is notified that the amendments put forth in Paper 20, 4/25/01, have been entered in full.

### ***Response to Amendment***

#### **Withdrawn Rejections:**

3. The rejection of claims 208, 210, 213, 214, 221-225, 228-231, 234, 236-240 under 35 U.S.C. 112, first paragraph, as put forth in item 8 Paper 12 (5/4/01) and reiterated in item 7 of Paper 14 (10/30/00), is withdrawn in view of Applicants' amendments put forth in Paper 20 and in view of the Declaration under 37 CFR 1.132 filed 4/25/01 as Paper 20 Exhibit 4, said

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Declaration being required to properly incorporate the Kaupmann *et al.* reference into the specification, MPEP § 608.01(p).

**New Rejections:**

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 208 and 210 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: a step that determines whether or not the recited chemical compound is an agonist of GABA<sub>B</sub>R1/R2 receptor. The claim requires the step of detecting an increase in activity of the GABA<sub>B</sub>R1/R2 receptor “so as to thereby determine whether the compound is an agonist of a GABA<sub>B</sub>R1/R2 receptor”. As currently worded, this step does not accomplish the goal of determining whether the compound is an agonist of a GABA<sub>B</sub>R1/R2 receptor. No criteria are set forth as to how the determination is made. The claims do not require that any particular activity indicates that the compound is an agonist of a GABA<sub>B</sub>R1/R2 receptor, thus the metes and bounds of the claim cannot be determined. It is suggested that replacing the phrase “so as to thereby determine whether the compound is an agonist of a GABA<sub>B</sub>R1/R2 receptor”, with the phrase “wherein said increase in activity indicates that the compound is an agonist of a GABA<sub>B</sub>R1/R2 receptor” would obviate this rejection.

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6. Claims 224, 225, 228-230 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims require that the artisan performing the method use a plurality of compounds “not known to activate a mammalian GABA<sub>B</sub>R1/R2 receptor”; this phrase renders the metes and bounds of the claim unascertainable because it is not clear whom the claim requires to not have known, nor to what time frame this lack of knowledge is applicable, and further, the bounds of the claim will change with time and with increases in knowledge.

***Allowable Subject Matter***

7. Claims 213, 214, 221-223, 231, 233-240 are allowable.

**Advisory Information**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (703) 306-5876. The examiner can normally be reached on Mondays through Thursdays from 8:00 a.m. to 5:30 p.m. The examiner can also normally be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, Ph.D., can be reached at (703) 308-6564.

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Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

MB

July 8, 2001

*James Romeo*  
*Primary Examiner*